

App. No. 10/727,299
Amendment Dated: January 31, 2006
Reply to Office Action of November 30, 2005

REMARKS/ARGUMENTS

In the Office Action mailed November 30, 2005, Claims 1-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mogilevsky (U.S. Patent 5,787,451) and further in view of Munro, J. "StarOffice 6.0 Lives UP to its Name," PCMAG.com, May 23, 2002 (hereinafter Munro). Claims 15-17 have been amended to correct informalities. No new matter has been added. In view of the amendments and the following remarks, reconsideration and allowance of all pending claims are respectfully requested.

Specification

The Office Action requested that the status (pending, allowed, etc.) of all parent priority applications that are listed in the first line of the specification. In response, Applicants have updated the status of the parent priority applications.

Claim Objections

Claims 15-17 were objected to because of informalities. In response, Applicants have amended Claims 15-17 to correct the informalities.

Claim Rejections

The Office Action rejected Claims 1-21 under 35 U.S.C. 103(a) as being unpatentable over Mogilevsky in view of Munro. With regard to Claim 1, the Office Action argues that "Mogilevsky teaches a word processor program with a spell checker" including "teaching storing spelling state codes within the document" but recognizes that Mogilevsky "does not teach an XML document." The Office Action also argues that "Munro, teaches spell checking of an XML document, specifically with the StarOffice6.0 software program." The Applicants respectfully disagree that the combination of Mogilevsky and Munro renders Claims 1-21

App. No. 10/727,299
Amendment Dated: January 31, 2006
Reply to Office Action of November 30, 2005

obvious. Further, the Office Action fails to specifically address each of the limitations that are found within Applicants' claims. For instance, Independent Claims 1, 8 and 15 each contain the recitation "a grammar error and a spelling error." The Office Action, however, fails to address these limitations and only addresses spell checking.

The closest argument with respect to grammar in general relates to the argument presented by the Office Action with regard to dependent Claim 7. With regard to Claim 7, the Office Action correctly states that "Munro does not teach a grammar state property" but argues that the grammar state property "is inherent from the examination of the document that a state property may be recorded for the grammar state as well as for the spelling state property." The Applicants respectfully disagree.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" MPEP § 2112 (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)).

Mogilevsky in the Abstract discloses a "method for checking spelling in a word processor [that] integrates spell checking with the editing process. ... the spell checker scans an open document, and maintains a table of spelling status data, including codes to identify checked, unchecked, or edited ranges of characters. ... Spelling status data is maintained with the document so that spell checked portions of the document do not need to be re-checked."

App. No. 10/727,299

Amendment Dated: January 31, 2006

Reply to Office Action of November 30, 2005

Munro discloses that the StarOffice 6.0 uses an XML-based file format and that it includes word processing capability and a spell-checker.

It is not inherent to include a grammar state as suggested by the Office Action merely because a document discloses the use of a spell checker. The Mogilevsky and Munro references do not teach or suggest "a grammar error." Should the Examiner not find these differences and arguments compelling, the Applicants respectfully request the Examiner to provide clear evidence that the missing descriptive matter is necessarily present in the spell checkers described within the Mogilevsky and Munro references.

Conclusion

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicant at the telephone number provided below.

Respectfully submitted,

MERCHANT & GOULD P.C.


Timothy D. Sullivan

Registration No. 47,981

Direct Dial: 206.342.6254

MERCHANT & GOULD P.C.

P. O. Box 2903

Minneapolis, Minnesota 55402-0903

206.342.6200

27488

PATENT TRADEMARK OFFICE